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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,795	12/13/2000	Robert E. Haines	10003227-1	3806

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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/738,795	HAINES, ROBERT E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thierry L. Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 7/21/05.
- Claims 1-32 are pending in application; claims 27-32 are newly added.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28, 30, and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The original filed specification does not provide an adequate written description of the newly cited limitations/features as recited in claims 28, 30, and 32, wherein “automatically generate and forward the second message to the interface without user intervention”. The examiner is unable to locate any teachings and/or features within the original filed specification that teaches the above limitations.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani (US 6108099), and in view of Beauchesne (US 6128626).

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Regarding claim 1, Ohtani discloses a consumable management device (*client computer 30, fig. 1*) comprising:

- an interface (*LAN I/F interface 30a, fig. 1*) configured to receive a first message including a first designation (*receiving first message from printer identifying consumable products such as empty toner and/or paper, fig. 4, col. 5, lines 4-52*) identifying an imaging consumable used by an image forming device to form hard images (*i.e. toner and/or paper, fig. 4*); and
- processing circuitry coupled (*inherently, all computers include a CPU*) with the interface, the processing circuitry being configured to generate a second message (*an email message including "model No. and manufacture number as shown in fig. 8 for forwarding to supplier for ordering the consumable parts, cols. 5-6*) including the second designation (*i.e. "model No and part number as shown in fig. 8*), and to forward the second message to the interface for communication to an entity (*email message is then forwarded to a supplier, fig. 4, cols. 5-6*) for assisting with replenishment of the imaging consumable.

Ohtani discloses a consumable management device, but fails to explicitly disclose wherein a processing circuitry configured to convert the first designation identifying the imaging consumable to a second designation identifying the imaging consumable.

Beauchesne, in the same field of endeavor for consumable management, teaches a processing circuitry (*client computer system 300 as shown in fig. 1*) configured to convert (*converting/corresponding/matching the manufacturer part number with customer part number, figs. 3-6, for example, fig. 5d shows component part number as a customer's part number with corresponding manufacturer's part number "mfg. Pn"*) the first designation identifying (*i.e. manufacturer's part number, figs. 3 & 5d*) the imaging consumable to a second designation (*i.e. customer's part number, fig. 3 & 5d, Beauchesne's system also includes a database for storing manufacturer's part number and customer's part number*) identifying the imaging consumable. Please also notes; it is also known in the art that before ordering any products from any manufacturers, the customers must know the part/product number and/or serial number. *Please also notes: claim 1 does not indicate what constitutes a "first and second designation message"*.

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying a consumable management device of Ohtani to include a processing circuitry configured to convert the first designation to a second designation (i.e. matching customer part number with manufacturer part number) as taught by Beauchesne because of a following reason: (●) allowing operators/users/clients to easily match the customer's part with manufacturer's part number by utilizing the database as shown in figs. 2-6 of Beauchesne without having to contact the manufacturer for part number; by doing so, it reduces time consumption and costs; (●) it improves the operability of the printing system by detecting and replacing the new parts as detected by the printer's sensors.

Therefore, it would have been obvious to combine Ohtani with Beauchesne to obtain the invention as specified in claim 1.

Regarding claim 2, Ohtani further discloses the device in accordance with claim 1 wherein the interface is configured to receive another first message (another message for toner, fig. 8) including another first designation identifying another imaging consumable (i.e. toner, fig. 8), and the processing circuitry is configured to convert the another first designation into another second designation identifying the another imaging consumable, and to generate the second message comprising a list (paper supply and toner supply, fig. 6-8) including the second designations. Please also see figs. 3-6 of Beauchesne for lists of products to be ordered.

Regarding claim 3, Ohtani further discloses the device in accordance with claim 1 wherein the processing circuitry is configured to generate the second message comprising a quantity (it is obvious to include a quantity within your purchase order as shown in fig. 6) corresponding to the imaging consumable identified by the second designation. Please also see figs. 3-6 of Beauchesne for quantity to be ordered.

Regarding claim 4, Ohtani further discloses the device in accordance with claim 1 wherein the processing circuitry is configured to generate the second message comprising

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an email message and to include the second designation as an attachment of the email (attached an order form as shown in fig. 6 to an email message). It is also known in the art that email software/programs are capable of attached files to an email message.

Regarding claim 5, Ohtani and Beauchesne further disclose the device in accordance with claim 1 wherein the processing circuitry is configured to convert the first designation comprising a manufacturer part number for the imaging consumable to the second designation comprising a customer part number (manufacturer's part number and customer's part number as shown in figs. 3-6 of Beauchesne) for the imaging consumable.

Regarding claim 6, Ohtani and Beauchesne further disclose the device in accordance with claim 1 further comprising storage circuitry configured to store a look-up table, and the processing circuitry is configured to access the look-up table (database contains plurality of look-up-table products, fig. 4 of Beauchesne) to convert the first designation to the second designation.

Regarding claim 7, Ohtani further discloses the device in accordance with claim 1 wherein the processing circuitry is configured to export the second designations into one of a plurality of formats (i.e. email message, fig. 6) corresponding to the entity to generate the second message.

Regarding claim 8, Ohtani further discloses the device in accordance with claim 1 wherein the processing circuitry is configured to communicate the second message at a predetermined moment in time (a purchase order can be sent to manufacturer at any time depends upon users' preferences). It is also known in the art to configure any email software to send out messages at predetermined moment in time.

Regarding claim 21, Ohtani further discloses the device in accordance with claim 1 wherein the entity comprises an initial entity (pc computer 30, fig. 1), and wherein the

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first designation is usable by another entity to identify the consumable (pc computer 30 for identifying what consumable products need to be ordered, figs. 4-8) and the second designation usable by the initial entity (a forwarded message with product number to a manufacturer, figs. 4-8 and col. 3, lines 1-5 and cols. 5-6) different than another entity to identify the consumable.

Regarding claim 22, Ohtani further discloses the device in accordance with claim 1 wherein the first designation is not recognizable by the entity (it is known in the art that customer product number is different than manufacturer product number; therefore, the customer product number is not recognizable by the entity).

Claims 9-13, and 23-24 are referring to a system (an image forming system as shown in fig. 1 by Ohtani includes image forming apparatus 20, LAN, PC 30, and server 40) for performing the method steps that limitations that are similar and in the same scope of invention as to those in claims 1-8, and 21-22; therefore, claims 9-13, and 23-24 are rejected for the same rejection rationale/basis as described in claims 1-8, and 21-22 above.

Claims 14-20, and 25-26 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-8, and 21-22; therefore, claims 14-20, and 25-26 are rejected for the same rejection rationale/basis as described in claims 1-8, and 21-22 above.

Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani and Beauchesne as applied to claims 1, 9, and/or 14 above, and further in view of Hayward et al (US 6798997).

Regarding claims 27, 29, and 31, combinations of Ohtani and Beauchesne fail to teach and/or suggest the processing circuitry is configured to forward the second message responsive to a predetermined status of the imaging consumable.

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Hayward teaches the processing circuitry (server 40, col. 9, lines 21-32) is configured to forward the second message responsive to a predetermined status (i.e. threshold conditions, col. 9, lines 21-32) of the imaging consumable.

It would have been obvious to one of ordinary skill in the art and well known at the time of the invention was made by modifying printing system of Ohtani and Beauchesne to include a processing circuitry configured to forward the second message responsive to a predetermined status of the imaging consumable as taught by Hayward because of a following reason: (●) to order replaceable consumable parts (i.e. ink cartridge, paper, toner, and etc) for printer based upon predetermined conditions (i.e. predicted date of depletion of supply and/or predicted date of need of consumable component) without human invention; (●) automatically re-order consumable part without human invention based upon predetermined conditions/statuses is to improve the performance of printing environment; for example, to prevent major delay and/or backlog of print jobs/orders by ensuring enough consumable resources (e.g. paper, toner, and etc) are available via predetermined conditions (i.e. predicted date of depletion of supply and/or predicted date of need of consumable component and order such components accordingly).

Therefore, it would have been obvious to combine Ohtani and Beauchesne with Hayward to obtain the invention as specified in claims 27, 29, and 31.

Regarding claims 28, 30, and 32, Hayward further teaches wherein the processing circuitry (server 40, col. 9, lines 21-32 and also col. 2, lines 5-63) is configured to automatically generate and forward the second message to the interface without user intervention.

### ***Response to Arguments***

Applicant's arguments filed 7/21/05 have been fully considered but they are not persuasive.

- Regarding claim 1, the applicant argued the examiner's motivation to combine the cited prior arts of record (US 6108099 to Ohtani and US 6128626 to Beauchesne) is



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insufficient and has failed to meet the burden of establishing a proper prima facie rejection.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivations to combine are: (●) allowing operators/users/clients to easily match the customer's part with manufacturer's part number by utilizing the database as shown in figs. 2-6 of Beauchesne without having to contact the manufacturer for part number; by doing so, it reduces time consumption and costs; (●) it improves the operability of the printing system by detecting and replacing the new parts as detected by the printer's sensors.

Ohtani teaches a printing system, wherein a printer detects consumable products need to be re-order, for example, print media. The printer sends the message to the official who administered the printer. The official is then generates a purchase order and transmits to the manufacturer. It is well known in the art that prior to place and/or transmit any order, one of ordinary skill in the art must include a part number along with purchase order. Well-known conventional method is to call a manufacturer and request for a part number that is corresponding with customer part number. The examiner admits Ohtani fails to include any methods and/or teachings of how to correspond a customer part number with manufacturer part number. Beauchesne teaches a database (for example, Excel spreadsheet) containing manufacturer part number that corresponds to customer part number. One of ordinary skill in the art (i.e. an official who administered the network printer as taught by Ohtani) is to use such database to convert and/or correspond the customer part number to manufacturer part number and incorporates such part numbers along with purchase order. The motivation to do so is provided above. The applicant repeatedly argued the claimed invention is to be performed (i.e. converting customer part to manufacturer part) without any human intervention. The examiner

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disagrees with such assertions/arguments. ***“Processing circuitry being configured to convert the first designation to second designation”*** as claimed in claim 1 ***does not inherently and/or exclusively means that it “must be performed” automatically without human invention.*** Nowhere within the original filed specification that teaches such features “conversion automatically without human intervention”. In broadest interpretations, the examiner interprets “being configured to convert” to be as “the user using the processing circuitry to convert/correspond customer part number with manufacturer part number”.

- Regarding claim 2, the applicant argued the cited prior arts of record fails to teach and/or suggest a second message comprising a list including a plurality of second designations of a plurality of image consumables.

In response, the examiner disagrees with the applicant’s argument. It is well known in the art that multiple consumable products can be ordered/purchased using a single purchase order. Please also see figs. 3-6 of Beauchesne for lists of products to be ordered.

- Regarding claim 5, the applicant argued the cited prior arts of record fails to teach and/or suggest any teachings of “part number”.

In response, the examiner disagrees with applicant’s argument. It is well known in the art that prior to place any purchase order, one of ordinary skill in the art must include a part number, and many examples are taught by Beauchesne.

- Applicant’s arguments, see page 8, filed 7/21/05, with respect to claims 21-26 have been fully considered and are persuasive. The 112, first paragraph rejection of claims 21-26 has been withdrawn.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- (●) U.S. 6405178 to Manchala, discloses a monitoring system for managing image forming apparatuses and automatically order consumable products.
- (●) U.S. 20020007318 to Alnwick, teaches a method for searching database for manufacturer part number with respect to customer part number.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

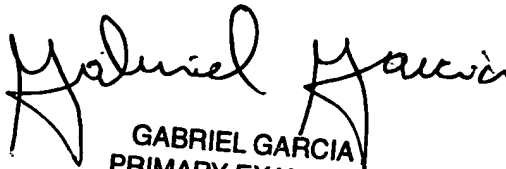
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER